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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,392	07/26/2004	Shohei Yasuda	40072-0010	3483

26633 7590 10/23/2006

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EXAMINER

CHUNG, SUSANNAH LEE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Office Action Summary	Application No.	Applicant(s)	
	10/502,392	YASUDA ET AL.	
	Examiner	Art Unit	
	Susannah Chung	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04, 8/12/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-5 are pending in the instant application.

Priority

This application is a 371 of PCT/JP03/01062, filed on 02/03/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) by application no. 2002-24900 filed in the Japanese Patent Office on 02/01/2002, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

Response to Election of Species

Applicant's election of formula (I), wherein R1 is 3,4-dimethoxyphenyl; R2 is ethy; and R3 is hydrogen in the reply filed on 8/31/2006 is acknowledged.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the election/restriction requirement as set forth in the Office action mailed on 8/4/2006 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

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Claim Rejections - 35 USC § 102

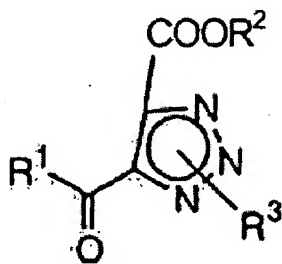
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

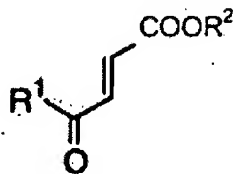
Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohtsuka, et al (U.S. Pat. No. 7,022,860).

Applicant's claims relate to a process for producing a 1,2,3-triazole compound



represented by formula (I),

, said process comprising the step of



reacting a compound represented by formula (II),

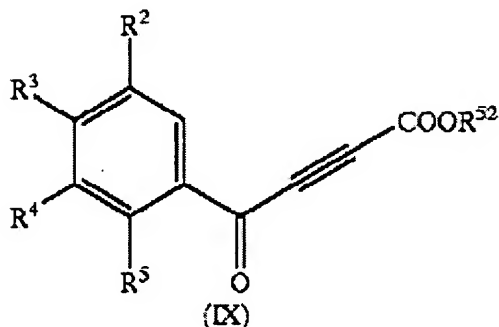
, with an azide compound

represented by formula (III), $R^3 \quad N_3$, in the presence of a transition metal compound.

Ohtsuka discloses this process that anticipates the instantly claimed process, wherein

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said process comprises the step of reacting a compound represented by formula (XI),



(which corresponds to Applicants formula (II), with an



azide compound represented by formula (X), (X) (which corresponds to Applicant's formula (III), in the presence of a transition metal compound. (see '735 Patent, column 15, lines 1-60 and column 14, lines 15-20 discuss the use of a transition metal compound). It should be noted that in both the prior art and the instant application, the transitional phrase comprising is used, which is open ended and could include additional steps not disclosed in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

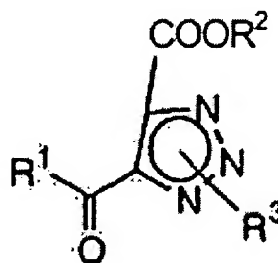
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

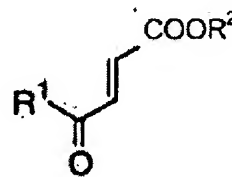
Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka et al., U.S. Pat. No. 5,840,895 ('895 Patent) (1998); U.S. Pat. No. 6,093,714 ('714 Patent) (2000); and U.S. Pat. No. 6,372,735 ('735 Patent).

Claims 1-5 of Applicant's instant elected invention teaches a process for producing a



1,2,3-triazole compound represented by formula (I),

, said process

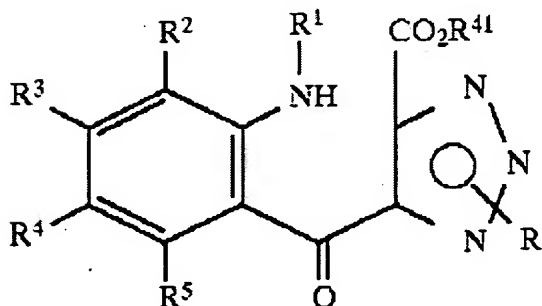


comprising the step of reacting a compound represented by formula (II),

with an azide compound represented by formula (III), $R^3 \quad N_3$, in the presence of a transition metal compound.

Determination of the scope and content of the prior art (MPEP § 2141.01)

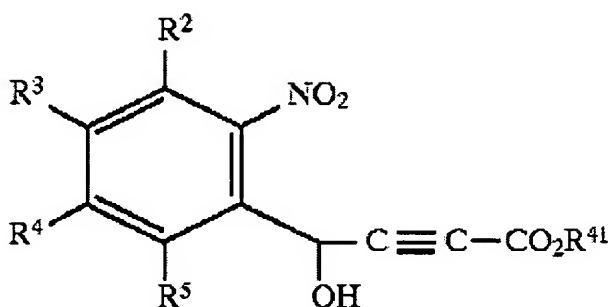
Ohtsuka teaches a process for preparing a compound of formula (III),



, which corresponds to Applicants formula (I), said

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process comprising the step of reacting a compound represented by formula (VII),



, with an azide compound represented by

formula (VIII), $R-N_3$ (VIII), in the presence of a transition metal compound. (see '714 Patent, column 10, reaction scheme, lines 38-70 and '895 Patent, column 20, Reaction Scheme (A), lines 1-70).

Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)

The difference between the prior art of Ohtsuka and the instant claims is that the prior art uses an alcohol, while the instant application uses a carbonyl group in the starting product. In the instant application, the oxidation process occurs before the addition of the azide, while in the prior art the oxidation of the alcohol occurs in a later step to obtain the same product.

Finding of prima facie obviousness - rationale and motivation (MPEP § 2142-2413)

One skilled in the art would have found the claimed process prima facie obvious because the instantly claimed process and the process in Ohtsuka only differ in the order, i.e. the timing of the oxidation step. In addition, the instantly claimed process uses the transition phrase "comprising" which is open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03. It is well established that changes in order of the reaction, minor changes in reaction conditions, are not patentable in the absence of unexpected results, which is different in kind and not degree. In addition, discovery of an optimum value of a result

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effective variable is not patentable if such discovery is within skill in the art. A prima facie case of obviousness may be rebutted in optimizing a variable only when results are unexpectedly good. In re Boesch, 205 USPQ 215. Therefore, the claimed process is prima facie obvious in light of the prior art unless applicant can show that oxidizing the alcohol at a later time yields *unexpectedly* good results and one skilled in the art may assume that since the products of the processes are the same that the enhancements made to the process in the instant application, would share the same properties as the prior art of Ohtsuka.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 1 is indefinite because the term “comprising” is open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03.

Objections

The Claims are objected to because of the following informalities: the heading of the claims reads a different docket number, serial number, and applicant. Appropriate correction is required. A telephone call was placed to Attorney Patricia Granados and it was confirmed the claims are correct and belong to the instant application.

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Telephone Inquiry

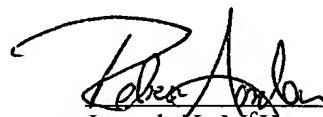
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098.

The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Date: 11 October 2006